

Notice of Allowability**Application No.**

10/630,423

Applicant(s)

CHADA ET AL.

Examiner

Anne Marie S. Wehbe

Art Unit

1633

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 3/9/09.
2. ☒ The allowed claim(s) is/are 1, 8 and 9.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
(a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
(b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413)
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

ATTACHEMENT TO NOTICE OF ALLOWANCE

Applicant's amendment and response received on 3/9/09 has been entered. Claims 2-3, 5, 16, 48-100, and 104-115 have been canceled. Of these, claims 4, 6-7, 10-15, 47, 102-103, and 116 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention or species, there being no allowable generic or linking claim. Claims 1 and 8-9 are currently under examination.

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Gary Gershik on 8/9/10.

The application has been amended as follows:

1. Claim 1 has been rewritten as follows:

Claim 1. A method of identifying genes that are over-expressed in adipocytes of white adipose tissue (WAT) from a first animal as compared to preadipocytes in WAT from a second animal comprising performing differential gene expression analysis between the WAT of the first animal and the WAT of the second animal, wherein the first animal is a HMGI-C ^{-/-} ob/ob

genotype mouse and the second animal is a HMGI-C $-/-$ genotype mouse, and wherein overexpression of a gene in the WAT of the first animal identifies a gene overexpressed in adipocytes.

2. Claims 4, 6-7, 10-15, 47, 102-103, and 116 have been canceled.

Following entry of this examiner's amendment, claims 1 and 8-9 remain pending in the instant application. In view of the above examiner's amendment the rejections of record of claims 1 and 8-9 under 35 U.S.C. 112, second paragraph, and under 35 U.S.C. 103(a) are withdrawn.

Claims 1 and 8-9 as amended above are considered allowed.

The following is an examiner's statement of reasons for allowance: claims 1 and 8-9 as amended by this examiner's amendment are free of the prior art of record, and in particular the teachings of Soukas et al. (2000) Genes and Development, Vol. 14, 963-980, and Anand et al. (2000) Nature Genetics, Vol. 24, 377-380 (both of record), because neither Soukas et al. nor Anand et al. teach or suggest that the WAT of HGMI-C $-/-$ ob/ob $-/-$ mice contains primarily adipocytes whereas the WAT of HGMI-C $-/-$ mice contains primarily preadipocytes such that differential gene expression analysis between the WAT from the HGMI-C $-/-$ ob/ob $-/-$ mice and the WAT from the HGMI-C $-/-$ mice could be used to identify genes overexpressed in adipocytes by identifying genes overexpressed in the WAT of the HGMI-C $-/-$ ob/ob mice.

It is further noted in regards to claim 8, that the recitation of the trademark "Affymetrix GeneChip" has a art recognized fixed and definite meaning such that its inclusion in the claim meets the requirements set forth in MPEP 608.01(v).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication from the examiner should be directed to Anne Marie S. Wehbé, Ph.D., whose telephone number is (571) 272-0737. If the examiner is not available, the examiner's supervisor, Joseph Weitach, can be reached at (571) 272-0739. For all official communications, the technology center fax number is (571) 273-8300. Please note that all official communications and responses sent by fax must be directed to the technology center fax number. For informal, non-official communications only, the examiner's direct fax number is (571) 273-0737. For any inquiry of a general nature, please call (571) 272-0547.

The applicant can also consult the USPTO's Patent Application Information Retrieval system (PAIR) on the internet for patent application status and history information, and for electronic images of applications. For questions or problems related to PAIR, please call the USPTO Patent Electronic Business Center (Patent EBC) toll free at 1-866-217-9197. Representatives are available daily from 6am to midnight (EST). When calling please have your application serial number or patent number available. For all other customer support, please call the USPTO call center (UCC) at 1-800-786-9199.

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